

REMARKS/ARGUMENTS

In response to the Final Office action of July 28, 2006, Applicants respectfully request that the instant amendment be entered, as it places the application in condition for allowance or in better form for appeal.

Premature Final Rejection

Applicants respectfully submit that the finality of the abovementioned Office Action is improper and should be vacated. Claim 20 (independent) and dependent claim 21 were previously rejected in the Non-Final Office Action of October 06, 2005 under USC 103(a) as being unpatentable over Kelley (US Pat. No. 4,754,379) in view of Kreutzer (US Pat. No. 4,402,542) in further view of Uccellini (US Pat. No 4,226,349). Applicants submitted a response (filed on January 10, 2006) to the outstanding Office Action which included no changes to pending claims 20 and 21. The Examiner then issued a Notice of Non-Compliant Amendment (mailed March 31, 2006) asserting that the response omitted a listing of pending claims 20 and 21. Applicants re-submitted the Response (filed May 08, 2006) including the missing claims 20 and 21. In the outstanding Final Office Action (mailed July 28, 2006) unamended claims 20 and 21 were then rejected by the Examiner under new grounds of rejection, that is, Kelley (US Pat. No. 4,754,379) in view of Kreutzer (US Pat. No.

4,402,542) in further view of Delorenzo (US Pat. No 6,415,732). This introduces confusion and uncertainty into the prosecution history of the instant application. Under present patent practice, a second Office action cannot be made final where the Examiner introduces a new ground of rejection that is neither necessitated by Applicants' amendment of the claims nor based on information submitted in an IDS filed during the period set forth in 37 CFR 1.97(c). See MPEP 706.07(a).

Claim Status/ Support for Amendments

No new matter has been added to the amendments to the specification made herein. In the specification, the paragraphs beginning at page 4 and page 9 have been amended to correct a typographical errors; "f" has been replaced with --of- and "must" has been replaced with --most-, respectively.

No new matter has been added to the amendments to the claims made herein. Claims 12, 14-16, and 18-21 are currently pending in this application.

Claims 12 and 20 have been amended herein to specifically recite a safety handle for temporary attachment to a pier piling for use by passengers during boarding and disembarking a boat, the safety handle comprising, *inter alia*, a base member having a front

surface including integrally formed rigid protrusions that temporarily prohibit movement of the base member when attached to the pier piling. Support for this amendment can be found throughout the specification as filed, see for example, page 9, lines 3-9; Fig. 3.

Rejections under 35 USC 103(a)

Claims 12, 14, 16, 18, 19 remain rejected under 35 U.S.C. 103(a), and claims 20 and 21 are now currently rejected under 35 U.S.C. 103(a), as being allegedly unpatentable in view of Kelley (US Pat. No. 4,754,379) in view of Kreutzer (US Pat. No. 4,402,542) in further view of Delorenzo (US Pat. No 6,415,732).

The Examiner asserts that Kelley teaches the "general concept" of a device for strapping a handle to an object of cylindrical shape. The Examiner admits that Kelley fails to teach; a base member constructed of flexible material, the handle being translucent and including a photo luminescent material, and the first and second strap positions near the top and bottom edges, as claimed. The Examiner asserts that Kreutzer teaches the concept of a base member meeting the claimed limitations. Thus, the Examiner concludes that it would have been obvious at the time the invention was made for one skilled in the art of have included in the design of Kelley such

a modification, for the purpose of providing a snug fit retention of a strapped object. The claimed method is allegedly inherent to the design.

Regarding the handle grip having a receptacle sized to receive a chemiluminescent light stick, the Examiner asserts that Delorenzo teaches the concept of a handle rail of photo luminescent material (an light stick 20) through a translucent material, for the purpose of being visible in the dark. Thus, the Examiner concludes that it would have been obvious at the time the invention was made for one skilled in the art to include such a modification in the device of Kelley, similarly to that taught in Delorenzo, for the purpose of allowing the handle to be visible in the dark.

With respect to the first and second straps positioned near the top and bottom edges, the Examiner generally asserts that it would have been an obvious matter of design choice to make the different portions of the device of whatever form or shape was desired or expedient. One reasons for doing such modifications might be for achieving a desired visually appearance.

Applicants respectfully disagree with the Examiner's determination that the invention as claimed is obvious. In order for an Examiner to establish a *prima facie* case of obviousness, three basic criteria must be met (MPEP 2142). First there must be

some suggestion or motivation, either in the references themselves or the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references) when combined must teach or suggest all of the claimed limitations.

Claims 12 and 20 have been amended herein to specifically recite a safety handle for temporary attachment to a pier piling for use by passengers during boarding and disembarking a boat, the safety handle comprising, *inter alia*, a base member having a front surface including integrally formed rigid protrusions designed to temporarily prohibit movement of the base member when attached to the pier piling, see page 9, lines 3-9 and Fig. 3 of the specification as originally filed.

Kelley discloses a flashlight (12) with a sling for carrying a thermos bottle (24) so the user can see the receptacle for the liquid in the bottle. Kelley device includes a plurality of straps (28) each having at its end fabric hook and pile (VELCRO) tabs (30, 31) for securing the thermos bottle against the support member (20). Clearly, VELCRO tabs are not rigid, nor designed to prohibit movement of the outer surface of the thermos.

The preamble of both claims 12 and 20 recite a safety handle

for temporary attachment to a pier piling for use by passengers during boarding and disembarking a boat. It has been held that the preamble can serve to limit claim scope if it "recites essential structure or steps", or it is "necessary to give life, meaning, and vitality" to the claim. *Catalina Mkrg. Int'l, Inc. v. Coolsavings Com. Inc.* 289 F.3d 801, 803, 808 (Fed. Cir. 2002), see also *Piney Bowes, Inc. v Hewlett-Packard, Co.* 182 F.3d 1298, 1305 (Fed. Cir. 1999). Applicants contend that the pier piling and boat are not merely statements of intended use as argued by the Examiner (see Final Office action; page 7, first fully paragraph). In this case, the pier and the boat are essential structures which are necessary to give meaning to the body of claims 12 and 20. Thus, these elements must be evaluated and considered just like any other limitation of the claim to determine whether the claim distinguishes over the prior art since it sets definite boundaries on the patent protection sought. Clearly, Kelley the flashlight sling is not used on a pier piling in the environment of boats.

Kreutzer discloses a sling with belts for carrying a tire. The engaging member (2) which faces away from the handle (1) includes strips (9) of soft elastic material having a high coefficient of friction, such as foam rubber (see column 2, lines 4-8). Obviously, these strips of elastic material are not rigid since this may cause

the tire held therein to rupture. Any attempt to include a sling with rigid protrusions would render the invention unsatisfactory for its intended purpose, namely, the transport of tires.

The Examiner is reminded that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See MPEP 2143.01 and *In re Gordon* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Delorenzo is drawn to a boat having a lighted grabrail. *Delorenzo* fails to teach or suggest a base member having a front surface and a back surface, the front surface including protrusions having a length sufficient to penetrate and frictionally engage the vertical piling.

Therefore, Applicants respectfully submit that the prior art references when combined fail to teach or suggest all of the claimed limitations. Moreover, there is no motivation for combining the dissimilar devices of *Kelley*, *Kreutzer*, and *Delorenzo* for the reasons delineated above. Even if there were a reason to combine, the result would not be a stationary handle for mounting on an immovable piling for stabilizing movement onto or off a boat.

Claim 15 remains rejected as obvious in view of Kelley (US Pat. No. 4,754,379) in view of Kreutzer (US Pat. No. 4,402,542). Applicants respectfully submit that is rejection is improper since claim 15 depends on claim 12. Claim 12 is currently rejected as being allegedly unpatentable in view of Kelley in view of Kreutzer in further view of Delorenzo (US Pat. No 6,415,732); thus, a proper rejection of claim 15 should be based on the combination of Kelley in view of Kreutzer in further view of Delorenzo. Moreover, it is respectfully submitted that the use of wood as a material does not provide the ability for Kelley to incorporate a flashlight in the handle, nor does it have any benefit for carrying wheels in the device disclosed by Kreutzer. Therefore, it is hereby request that this rejection be withdrawn or at least clarified by the Examiner.

Claims 12, 14, 16 and 18-21 currently stand rejected under 35 USC 103(a) as being allegedly unpatentable over Steel (US Pat. no. 6,840,186) in view of Kreutzer (US Pat. No. 4,402,542) in further view of Delorenzo (US Pat. No 6,415,732).

As set forth above, claims 12 and 20 have been amended herein to specifically recite a safety handle for temporary attachment to a pier piling for use by passengers during boarding and

disembarking a boat, the safety handle comprising, *inter alia*, a base member having a front surface including integrally formed rigid protrusions designed to temporarily prohibit movement of the member attached to the piling.

Steel discloses a cleat for securing a boat to a piling. According to one embodiment of Steel, the base may include of a plurality of optional through-bores, not shown, designed to receive fasteners, such as bolts, to permanently secure the cleat (10) on the dock. This is in direct contrast to the invention, as currently claimed, wherein the front surface of the base member includes a plurality of integrally formed rigid protrusions designed to temporarily prohibit movement of the base member attached to the pier piling. The temporary attachment of the handle to the pier pilings is critical to the present invention, since most marinas forbid anyone from attaching handles or other items to a piling by use of nails and screws since this exposes the inner wood to the elements which can result in quicker drying of the wood and wood splinters, as described at page 4, lines 6-11, page 5, lines 21-22 and page 9, lines 3-9 of the specification.

Kreutzer discloses a sling with belts carrying for a tire. The engaging member (2) which faces away from the handle (1) includes strips (9) of soft elastic material having a high

coefficient of friction, such as foam rubber (see column 2, lines 4-8). As discussed above, the strips (9) of soft elastic material having are by definition not rigid. Any attempt to include a sling with rigid protrusions would render the invention unsatisfactory for its intended purpose, namely, to transport tires.

Delorenzo, as discussed above, is drawn to a boat having a lighted grabrail. Delorenzo fails to teach or suggest a base member having a front surface and a back surface, the front surface including a plurality of rigid protrusions.

Therefore, Applicants respectfully submit that the prior art references when combined fail to teach or suggest all of the claimed limitations. Moreover, there is no motivation for combining the dissimilar devices of Steel, Kreutzer, and Delorenzo for the reasons delineated above.

Claim 15 remains rejected as obvious in view of Steel (US Pat. no. 6,840,186) in view of Kreutzer (US Pat. No. 4,402,542). Applicants respectfully submit that is rejection is improper since claim 15 depends on claim 12. Claim 12 is currently rejected as being allegedly unpatentable in view of Steel in view of Kreutzer in further view of Delorenzo (US Pat. No 6,415,732); thus, a proper rejection of claim 15 should be based on the combination of Steel in view of Kreutzer in further view of Delorenzo. Therefore,

favorable reconsideration or at least clarification of the instant rejection is respectfully requested.

Therefore, Applicants respectfully submit that the prior art references when combined fail to teach or suggest all of the claimed limitations. Moreover, there is no motivation for combining the dissimilar devices of Steel, Kreutzer, and Delorenzo for the reasons delineated above.

CONCLUSION

In light of the foregoing remarks, amendments to the specification and claims, favorable reconsideration of the application is courteously requested. Should there be any remaining issues which can be resolved via an Examiner's Amendment, the Examiner is urged to call the undersigned in order to expedite the prosecution of this application.

Respectfully submitted,

Michael A. Slavin
Registration # 34,016

McHale & Slavin, P.A.
2855 PGA Boulevard
Palm Beach Gardens, FL 33410
(561) 625-6575 (Voice)
(561) 625-6572 (Fax)